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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,144	02/14/2002	Doreen S. Rao	BSCU-237/00US 027060-3165	6889
58349      7590      02/03/2010 COOLEY GODWARD KRONISH LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001				
EXAMINER				
MCEVOY, THOMAS M				
ART UNIT		PAPER NUMBER		
3731				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/075,144

**Applicant(s)**

RAO ET AL.

**Examiner**

Thomas McEvoy

**Art Unit**

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 4, 5, 7, 10-12, 15, 18-20 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 8, 9, 14, 17, 22, 28-31, 33, 34, 36-39, 41, 42, 46, 48-53, 60-64, 66 and 69-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1,2,4-12,14,15,17-20,22,23,28-31,33,34,36-39,41,42,46,48-53,60-64,66 and 69-84.

### **DETAILED ACTION**

1. Currently claims 1, 2, 4-12, 14, 15, 17-20, 22, 23, 28-31, 33, 34, 36-39, 41, 42, 46, 48-53, 60-64, 66 and 69-84 are pending. Claims 4, 5, 7, 10-12, 15, 18-20 and 23 have been withdrawn. Claims 3, 13, 16, 21, 24-27, 32, 35, 40, 43-45, 47, 54-59, 65, 67 and 68 have been cancelled. Claims 1, 2, 6, 8, 9, 14, 17, 22, 28-31, 33, 34, 36-39, 41, 42, 46, 48-53, 60-64, 66, 69-84 are considered below.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 20<sup>th</sup> 2009 has been entered.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1, 2, 6, 8, 9, 14, 17, 22, 28-31, 33, 34, 36-39, 41, 42, 46, 48-53, 60-64, 66 and 69-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tobita (US 5,669,239) alone or in view of Barr (US Des. 265,894).

Regarding claims 1, 17, 22, 36, 46, 48, 49, 60-64 and 66, 69-76, Tobita discloses a device for treating a body canal (ear piercing) comprising a device capable of medical use (earrings with straight posts are used to promote healing of ear piercings; see attached references cited) that includes a proximal end-piece positioned at a proximal-most end of said medical device (sphere at end in Figure 8) and an elongated body portion (member 21 and chain, Figure 8). Tobita fails to disclose a distal end-piece positioned at a distal end of said medical device, where the end-pieces have substantially the same non-looped shape. Tobita does suggest that it is desirable to have accessory end-pieces on each end of an earring (col. 4, lines 9-12; Figure 7). Therefore, it would have been obvious to one of ordinary skill in the art to have provided the known Figure 8 earring with ornaments (sphere and chain) at both ends as an obvious matter of design choice. It would have been obvious to one of ordinary skill in the art to have attached a loop of the chain around/through the loop 27 of the nut because the skilled artisan would recognize this as an obvious way to attach one chain loop to another loop. However, if this rationale is not persuasive, attention is drawn to Barr who teaches that an ornament

of very similar structure can be attached to a nut of identical structure by securing the ornament loop around the nut loop (Figure 3). It would have been obvious to one of ordinary skill in the art in view of Barr to have attached the chain loop to the nut loop 27 in this manner in order to modify the known earring with an ornament on the back side as suggested by Tobita. With this modification, the elongated body portion would be disposed between the proximal end-piece and a distal end-piece and the body portion would comprise a plurality of interconnected loops directly connected to the proximal end-piece and the distal end-piece. The interconnected loops are configured to fit within a body canal, where each of the loops comprises a member defining at least one opening, the member of each loop passing through at least one opening of another loop to form the plurality of interconnected loops. Adjacent interconnected loops are moveable along each of an X, Y, and Z orthogonal axis relative to each other at least during deployment of the medical device in the body canal. The elongated body portion further comprises a substantially cylindrical non-loop segment (member 21) and would comprise a first end directly connected to a first loop of the interconnected loops and a second end directly connected to a second loop 27 of said interconnected loops. A cross-sectional diameter of at least one (and therefore both) of the end-pieces is larger than a diameter of a remainder of the medical device (where this claim limitation implies that both end pieces can be the same size). Tobita fails to specifically disclose that the loops are made of a biodegradable material but does disclose that

other parts of the device can be made of iron (col. 4, lines 5-8). It would have been obvious to one of ordinary skill in the art to have made other parts of the device, including the loops, out of iron since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. The non-loop segment can be made out of a compressible material such as gold or plastic (col. 4, lines 5-8). Regarding claim 2, the body portion comprises discrete loops (Figure 8). Regarding claim 6, at least one of the loops is substantially circular (Figure 8). Regarding claims 8, 33, 41 and 52, a member of at least one of the loops comprises a substantially circular cross-section (Figure 8). Regarding claims 9, 34, 42 and 53, at least one of the members comprises a closed loop (Figure 8). Regarding claims 14 and 50, a surface of the body segment is uneven (at 3 or at 10 in Figure 1, for example). Regarding claims 28 and 29, at least one of the endpieces is capable of holding a respective end of the device at a specific anatomical location such as a renal pelvis, a urinary bladder, or a blood vessel. Regarding claim 30, with the above modification, a proximal loop member would be joined to the proximal end-piece and a distal loop member would be joined to the distal end-piece. Regarding claim 31, Tobita does not specifically disclose how the loops are attached to the end-pieces. However, it is old and well-known in the art that articles of jewelry are connected by welding or soldering. The above well-known in the art statement is taken to be admitted prior art because Applicant failed to traverse Examiner's assertion (MPEP 2144.03). Regarding claim 37, each of the plurality of

interconnected loops is configured to move within the confines of the opening of an adjacent loop (Figure 8). Regarding claim 38, the interconnected loops are configured to permit fluid to pass through each at least one opening (Figure 8). Regarding claim 39, an axial length of the body portion is adjustable (by bending and/or compressing the chains or by the Figure 1 mechanism). Regarding claim 51, the segment is substantially tubular inasmuch as Applicant's Figure 2 or 3A segments are.

6. Claims 77-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tobita (US 5,669,239) alone or in view of Barr (US Des. 265,894) and further in view of Mancini (US 4,307,582).

Regarding claims 77-84, Tobita in view of Barr disclose the device as described above but fail to disclose that the outer surface of the non-loop segment is wavy. Mancini disclose a non-loop segment which is wavy in order to provide multiple securing positions for the end nut so that the device can be adjusted for different ear lobe widths (col. 2, lines 52-55). it would have been obvious to one of ordinary skill in the art in view of Mancini to have modified the non-loop segment of Tobita to include the wavy structure of Mancini in order to provide multiple securing positions for the end nut. However, if it is not convincing that the structure of the Mancini non-loop segment is wavy, it would have also been obvious to one of ordinary skill in the art to have provided multiple depressions 32 in close enough proximity so that a wavy pattern is formed in order to provide more securing positions as suggested by Mancini (col. 2, lines 57-58).



***Response to Arguments***

7. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas McEvoy whose telephone number is (571) 270-5034. The examiner can normally be reached on M-F, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas Mcevoy/  
Examiner, Art Unit 3731

/Anhtuan T. Nguyen/  
Supervisory Patent Examiner, Art Unit 3731  
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